

### **REMARKS**

Further and favorable reconsideration of the instant application, pursuant to and consistent with 37 C.F.R. §§ 1.113, is respectfully requested.

### **Status**

Claims 1-31 are pending in this application. *Final Office Action mailed July 2, 2007, Office Action Summary, Item 4.* Claim 31 is allowed. *Id. at Item 5.* Claims 1-11, 13, 14, 16, 17, 25, and 29 stand rejected. *Id. at Item 6.* Claims 12, 15, 18-24, 26-28, and 30 are objected to. *Id. at Item 7.*

### **Request for Teleconference with the Examiner**

Applicants' undersigned representative spoke with Examiner Trimiew briefly on October 11, 2007. Applicants' representative requested a brief telephonic or personal interview regarding this application. Examiner Trimiew indicated that such an interview was not available, but (1) recommended that Applicants submit an After Final Response; and (2) indicated that she would telephone Applicants' undersigned representative when considering the After Final Response. **Accordingly, Applicants request that Examiner Trimiew telephone Ms. Erin Dunston at 202-373-6162 when this Response is being considered so that issues may be discussed prior to further action by the Office.**

### **Allowable Subject Matter**

Applicants note with appreciation that the Examiner has indicated that "Claims 12, 15, 18-24, 26-28, [and] 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims.” *Final Office Action mailed July 2, 2007, Page 2, Last Paragraph.*

**Fundamental Difference Between Applicants' Claimed Invention And That Of The '160 Patent**

The Examiner is of the opinion that “the water-activated mask in the [U.S. Patent No. 6,358,160 (“the ‘160 patent”)] is the glossy coat on the outer layer of the ball. Once the coating is penetrated the indicia appears. Therefor[e] the glossy coating is equivalent to applicant’s masking layer. Also, the claims do not require the masking layer to be opaque.” *Final Office Action mailed July 2, 2007, Page 3, First Paragraph.*

Applicants respectfully and completely disagree. There is a fundamental misunderstanding between Applicants and the Examiner with regard to their invention as it pertains to the ‘160 patent.

The method of Claim 1 requires applying a water-activated mask to a golf ball that *already contains* an indicator. When the golf ball is subjected to water, the mask is activated such that it is altered so as to permit viewing of the underlying, already existing indicator.

The method of Claim 1 employs a golf ball that contains an indicator that is already in its final indicator state. The indicator is not initially visible, as it is hidden by a mask. If, however, the golf ball is exposed to water, the mask is activated. Upon activation, the mask is altered to permit viewing of the indicator. The important point is that the indicator does not change. Instead, only the mask, upon being activated by water, changes.

The golf balls claimed in the ‘160 patent are different from the golf balls employed in Applicants’ claimed methods because the golf balls claimed in the ‘160 patent have imprints upon them made with a water-activated ink and those imprints change when exposed to water.

The golf balls claimed in the '160 patent are different from the golf balls employed in Applicants' claimed methods because the golf balls in the '160 patent have imprints upon them made with a water-activated ink. Because those imprints are made with water-activated ink, they need not be hidden from view and thus require no masking layer. Should another layer be coated over those imprints the coating need not be opaque and, in fact, may be transparent or clear. Because the imprints are made using water-activated ink, the ink changes upon exposure to water and thus the imprints themselves change in the golf balls in the '160 patent. This stands in stark contrast to the golf balls employed in Applicants' claimed methods whose indicator is already in its final indicator state and does not change upon exposure to water.

Applicants submit that when this fundamental difference between Applicants' claimed invention and the invention of the '160 patent is appreciated, it becomes apparent that the '160 patent neither anticipates nor renders obvious Applicants claimed methods.

**Rejections Under 35 U.S.C. § 102(b) and/or 35 U.S.C. § 103(a)**

Claims 1-11, 13, 14, 16, 17, 25, and 29 were rejected under 35 U.S.C. § 102(b) as purportedly anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as purportedly obvious over the '160 patent to Winskowicz. *Office Action mailed July 2, 2007, Page 2, Middle Paragraph.* According to the Examiner, "Winskowicz discloses a golf ball comprising a surface with indicia and a gloss coating (masking layer) over the surface. Once the coating is penetrated the indicia will appear on the surface (fig 9). The indicia indicates the ball has been exposed to water and has changed characteristics. With respect to claims 2-5, the coating layer obviously includes all the limitations when exposed to water. The

coating layer also include[s] a water activated binder since it is capable of being penetrated by water.” *Id.* This rejection is respectfully traversed.

**A. Purported Anticipation Under 35 U.S.C. § 102(b)**

“Invalidity based on ‘anticipation’ requires that the invention is not in fact new.”

*Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002) (quoting *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995)). “A single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art.” *Verve*, 311 F.3d at 1120 (citing *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)). Put differently, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Applicants respectfully submit that the ‘160 patent fails to disclose each and every element of Claims 1-11, 13, 14, 16, 17, 25, and 29. For example, Claim 1 (from which Claims 2-11, 13, 14, 16, 17, 25, and 29 depend) is a method claim. Claim 1 is a method for providing a golf ball with a visual indication that at least one property of the golf ball has been altered due to the presence of water, comprising applying a water-activated mask that is altered to permit viewing of a covered indicator upon being subjected to water. **The method of Claim 1 requires applying a water-activated mask. Once the mask is activated with water, the indicator over which the mask was applied becomes viewable.** The mask may be referred to as an “opacification layer.” As Page 5, Lines 2-5 of the Specification state, “Under normal conditions the opacification layer blocks the view of the underlying surface. When the opacification layer is water-activated it becomes transparent or is removed, thus unmasking the underlying layer.” Page 5, Lines 7-9 of the Specification further state,

“Depending on the type of physical operation involved, immersion of the golf ball for a sufficiently long period of time causes the opacification layer to either be rendered transparent, to be removed, or to reduce its light-blocking characteristics.”

The ‘160 patent does not anticipate Claims 1-11, 13, 14, 16, 17, 25, and 29 because **the ‘160 patent is silent with regard to Applicants’ claimed water-activated unmasking of an already existing indicator.** The invention of the ‘160 patent is summarized at Column 1, Line 59 through Column 2, Line 9 of the ‘160 patent:

In order to alleviate the problem of having to deal with balls which may have been immersed and recovered, in the subject invention a golf ball is provided which changes color, has imprinted writing which disappears or has some other indicia which changes after immersion to indicate that the ball has been immersed.

In the present invention, in one embodiment, imprints on the ball are made with water-activated ink which vanishes when it is exposed to water for long periods of time. In another embodiment, imprints on the ball are made with water-activated transparent ink which appears when it is exposed to water for long periods of time. The invention is thus used as an indicator of balls previously exposed to water . . . for one to several days in the bottom of a lake, pond, pool or other body of water. Such an indicator is used to alert golfers to potential changes in ball properties due to long water exposure times.

The instant application reiterates the attributes of the ‘160 patent when it states:

“Note that U.S. Patent 6,658,160 utilizes water-activated ink which either appears or disappears upon the immersion of the golf ball in water.” *Page 3, Lines 18-19 of the Specification.*

Applicants’ instant application distinguishes the claimed invention from that of the ‘160 patent by explaining that “a golf ball with indicia or a particular recognizable color is **overlain with an opacification layer that provides a mask over the indicia or the colored ball . . .** The opacification layer when removed or otherwise made transparent, while

providing for a change in the appearance of the golf ball upon water immersion, does not need to have a layer or indicia which changes color in reaction to the infusion of water.”

*Page 8, Lines 4-11 of the Specification (emphasis added).*

The ‘160 patent does not disclose or suggest a method for providing a golf ball with a visual indication that a property has been altered where a water-activated mask is applied to an indicator, whereby upon activation the mask permits viewing of the covered indicator. Thus, the ‘160 patent does not anticipate Claims 1-11, 13, 14, 16, 17, 25, and 29. Applicants respectfully request withdrawal of the rejection of Claims 1-11, 13, 14, 16, 17, 25, and 29 under 35 U.S.C. § 102(b) over the ‘160 patent.

**B. Purported Obviousness Under 35 U.S.C. § 103(a)**

Applicants respectfully submit that a *prima facie* case of obviousness has not been made against Applicants’ Claims 1-11, 13, 14, 16, 17, 25, and 29 at least because the ‘160 patent fails to disclose or suggest Applicants’ methods employing water-activated masks that are altered to permit viewing of covered indicators, *i.e.*, the ‘160 patent fails to teach or suggest all of the limitations of Claims 1-11, 13, 14, 16, 17, 25, and 29. *See above.*

In view of the foregoing, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of Claims 1-11, 13, 14, 16, 17, 25, and 29 over the ‘160 patent.

Applicants take this opportunity to again address the relationship between the ‘160 patent and the instant application. The claims of the ‘160 patent are broad, in that they use open-ended “comprising” language. In that regard, the claims of the ‘160 patent could be said to dominate Claims 1-31 in the instant application. A useful discussion of this is set

forth in *In re Kaplan*, 789 F.2d 1574 (Fed. Cir. 1986), previously submitted for the

Examiner's convenience:

By domination we refer, in accordance with established patent law terminology, to that phenomenon, which grows out of the fact that patents have claims, whereunder one patent has broad or "generic" claims which "reads on" an invention defined by a narrower or more specific claim in another patent, the former "dominating" the latter because the more narrowly claimed invention cannot be practiced without infringing the broader claim. To use the words of which the board seemed to be enamored, the broader claim "embraces" or "emcompasses" the subject matter defined by the narrower claim. In possibly simpler terms, one patent dominates another if a claim of the first patent reads on a device built or process practiced according to the second patent disclosure.

*In re Kaplan*, 789 F.2d at 1577. While the claims of the '160 patent may dominate Claims 1-31 of the instant application, the claims of the '160 patent neither anticipate nor render obvious Claims 1-31, at least because the '160 patent is silent with regard to Applicants' water-activated mask that is altered to permit viewing of a covered indicator upon being subjected to water.

**CONCLUSION**

It is respectfully submitted that all rejections have been overcome by the foregoing amendments and remarks. Thus, a Notice of Allowance is respectfully requested.

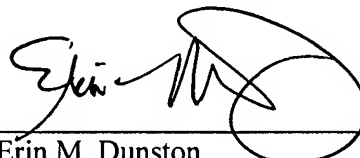
In the event that there are any questions relating to this Amendment and Reply Pursuant to 37 C.F.R. § 1.111, or to the application in general, it would be appreciated if the Examiner would contact Applicants' undersigned attorney by telephone at (202) 373-6000 so that prosecution of the application may be expedited.

The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2518.

Respectfully submitted,  
BINGHAM MCCUTCHEN, LLP

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